

REMARKS

The Examiner has made a restriction requirement under 35 U.S.C. § 121 between the inventions of Group I, claims 1-10, directed to an aqueous solution with embedded nanoparticles, Group II, claims 11-12, directed to a method of making nanoparticles, and Group III, claims 18-21, directed to a coating process. The Examiner's alleged basis for the restriction is that the claims in Group I include a product that can be made by a process not included in Group II, that the claims in Group I include a product that can be used in other processes not included in Group III, that subcombinations of Groups II and III are usable together in a single combination and that the Group III process does not require the Group II process.

The Examiner made a species restriction within Group III consisting of Species A-1 (claim 18), to a coating method for forming an ionomer membrane; Species A-2 (claim 19), to a coating method for forming a gas diffusion electrode; Species A-3 (claims 20 and 21), to a coating method for forming carbon-supported electrocatalysts.

The Examiner also made a species restriction consisting of Species B-1 (claim 13), to a catalyzed ionomer membrane; B-2 (claim 10), to a gas diffusion electrode; B-3 (claims 15 and 22), to a membrane electrode assembly; Species B-4 (claim 16), to a supported electrocatalyst; Species B-5 (claim 17), to a catalyst ink; and Species B-6 (claim 23), to a fuel cell stack.

Under MPEP 803, the criteria for a proper restriction requirement are: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. Applicants respectfully submit that the Examiner has not met the burden of establishing two or more independent and distinct inventions claimed in one application under 35 U.S.C. § 121. For example, the claims of Group II recite processes for making the nanoparticles of Group I. Applicants submit that a search for either Group would reveal references relevant to both Groups, and thus pose no extra search burden on the Examiner. The claims of Group I and Group III are

related in that claim 18 in Group III recites a process for the catalytic coating of a gas diffusion electrode by applying the nanoparticles of claim I in Group I. Applicants submit that a search for either Group I or Group III would reveal references relevant to both Groups, and thus pose no extra search burden on the Examiner. As presently claimed, the inventions of Group III, like the inventions of Group II, refer to the nanoparticles of claim 1 in Group I. Thus, a search for either Group II or Group III would reveal references relevant to both Groups, and thus pose no extra search burden on the Examiner. Accordingly, the restriction requirement should be withdrawn.

Since a response to this restriction requirement must include an election of the invention to be examined, even though the requirement may be traversed, Applicants hereby elect, with traverse, Group I, claims 1-10, for prosecution at this time.

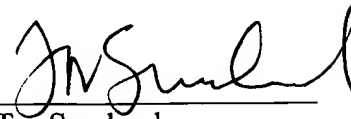
With respect to the species restrictions, election among Species A is moot because Group III was not elected for prosecution at this time. As to Species B, Applicants also submit that the Examiner has failed to set forth a prima facie case for species restriction. For example, each of the cited species B-1 to B-6 includes the nanoparticles of claim 1 as an element. Thus, a search for any of these species would reveal references relevant to each species, and thus pose no extra search burden on the Examiner. Accordingly, these species restrictions should be withdrawn. Nevertheless, because a response to this restriction requirement must include an election of species, even though traversed, Applicants hereby elect with traverse the species of claims 15 and 22, directed to a membrane electrode assembly, to prosecute at this time.

The Examiner is invited to call Applicants' attorney at the telephone number listed below to clarify this restriction requirement.

No fee is required in connection with the filing of this communication. If additional fees are deemed necessary for the filing of this response, authorization is hereby given to charge any such fees to Deposit Account No. 11-0171.

Applicant: Starz et al.
Ser. No.: 09/910,959
Response to Restriction Requirement
Date: July 21, 2003
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Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tor Smeland', written over a horizontal line.

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